APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,341	01/11/2002	Wayne A. Provost	14689.11	8023

22913	7590	06/20/2006	

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER
TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/044,341	PROVOST ET AL.
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 May 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>11 January 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>5/2/2006</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1.   This communication is in response to the application filed on 5/2/2006. Claims 1,

11, 12, 14, and 21 have been amended. Claims 1-26 are pending. The IDS statement

filed on 5/2/2006 has been entered and considered.

Specification

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   The specification is objected to under 35 U.S.C. § 112, first paragraph, because

the specification, as originally filed, does not provide support for the invention as is now

claimed for the reasons in section 4, *infra*.

4.   The amendment filed 5/2/2006 is objected to under 35 U.S.C. 132(a) because it

introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows:

The newly added recitations within claims 1-9, 14, 17, 20, and 24. For example,

the recitation of "selecting the supporting document based on *information including one*

of a diagnostic code or a treatment code" [Emphasis added] does not appear to be

supported.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5.   Claims 1-33 are rejected under 35 U.S.C. § 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention and for the reasons set

forth in the objection to the specification in section 4, *supra.*

Claims 1, 12, 14, and 21 recite limitations that are new matter, as discussed

above. Claims 2-13, 15-20, and 22-26 incorporate the deficiencies of claims 1, 12, 14,

and 21 through dependency and are also rejected.

Applicant is advised to provide support for all features added to the amendment

filed on 5/2/2006.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the
amendment filed on 5/2/2006 is not new matter and are provided
hereinbelow for Applicant's consideration on the condition that Applicant
properly traverses the new matter objections and rejections set forth in
sections 2-5, *supra*, in the next communication sent in response to the
present Office Action.

7.   Claims 1, 2, 5-17, and 19-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Joao (6,283,761; hereinafter Joao) in view of Peterson et al.

(6,343,271; hereinafter Peterson), and in view of Applicant's prior art admissions in the

background of the invention of the present application (10/044,341).

(A) As per claim 1, Joao discloses in a server system that communicates with a

client system associated with a health care provider and is adapted to facilitate

processing of an insurance claim, a method of delivering a supporting document to a

carrier to enable the carrier to process an insurance claim, the method comprising the

acts of:

       (1) receiving an insurance claim from the client system (Joao: abstract; col. 2,

           line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7);

       (2) <u>transmitting a request to the client system for the supporting document</u>

           (Joao: col. 35, lines 40-53);

       (3) receiving the supporting document associated with the insurance claim in

           an electronic format from the client system (Joao: col. 2, line 25-col. 3, line

           45; col. 4, line 59-col. 5, line 7);

       (4) <u>storing the supporting document in a database</u> (Joao: col. 35, line 65-col.

           36, line 5); and

       (5) notifying the carrier that an electronic image of the supporting document is

           available to enable the carrier to process the insurance claim (Joao: col. 4,

           lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62).

Joao, however, fails to *expressly* disclose in a server system that communicates

with a client system associated with a health care provider and is adapted to facilitate

processing of an insurance claim, a method of delivering a supporting document to a

carrier to enable the carrier to process an insurance claim, the method comprising the

acts of:

> (6)   *identifying* a supporting document to be submitted with the insurance
>
> claim based on information included in the insurance claim [Emphasis
>
> added.].

Nevertheless, these features are old and well known in the art, as evidenced by

Peterson and Applicant's prior art admissions. In particular, Peterson discloses in a

server system that communicates with a client system associated with a health care

provider and is adapted to facilitate processing of an insurance claim, a method of

delivering a supporting document to a carrier to enable the carrier to process an

insurance claim, the method comprising the acts of:

> (6)   identifying a supporting document to be submitted with the insurance
>
> claim based on information included in the insurance claim (Peterson:
>
> abstract; col. 3, lines 19-30) (Examiner notes that Peterson teaches a
>
> claim processing system "that would more easily allow health care
>
> providers to know (i.e. identify) what patient and treatment information
>
> (i.e., supporting documents) must accompany insurance claims.).

Examiner also notes Applicant's prior art admissions within the background of the

present application. For example, Applicant makes the following admissions:

> "... requiring numerous supporting documents to accompany
> a health care insurance claim. These supporting
> documents, such as laboratory reports, X-rays, physician
> notes, patient charts, discharge papers, etc. are typically
> need [sic] before processing of the health care insurance
> claim can occur."
>
> "Consequently the institutional health care provider often
> receives a request for the supporting documents..."
>
> "...an employee must collect the needed documents, obtain
> hardcopies of the documents, and mail the copies to the
> carrier."
>
> "...often necessary for carriers or payers to spend additional
> time reviewing and analyzing claims [for missing
> information]..."

As such, Examiner acknowledges the following to be well known and obvious:

- Supporting documents relating to health care insurance claims;

- Receiving requests for supporting documents;

- Collecting/Identifying needed supporting documents;

  (Examiner notes that before a carrier can determine if a claim is missing
  supporting documents and other information (i.e., the claim is incomplete),
  the carrier must first identify what supporting documents and other
  information is required. In other words, one cannot determine a claim is
  incomplete without knowing what needs to be included to begin with (i.e.,
  identifying a supporting document to be submitted).

- Transmitting/Receiving supporting documents; and

- Carriers/Payers deduce/identify what supporting documents are missing or need to be submitted based on information, such as diagnosis or procedure/treatment information (i.e., ICD or CPT codes), within the insurance claim.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson and Applicant's prior art admissions with the teachings of Joao with the motivation of avoiding claim processing delays resulting from claim submissions with too little information (Peterson: col. 3, lines 23-30).

(B)   As per claim 2, Joao discloses a method as recited in claim 1, further comprising the act of transmitting information to the client system that causes the client system to prompt a user of the client system to submit the supporting document associated with an insurance claim (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(C)   As per claim 5, Joao discloses a method as recited in claim 1, further comprising the acts of:

(1)   transmitting claim information associated with the insurance claim to payment entity, wherein, upon receiving the claim information, the payment entity advances money to the client system prior to the carrier

making payment on the insurance claim (Joao: col. 37, lines 48-65; fig. 1);

and

(2)   transmitting the insurance claim to the carrier, wherein, upon receiving the

insurance claim, the carrier makes payment on the insurance claim to the

payment entity, thereby paying for the money advanced to the client

system (Joao: col. 37, lines 48-65; fig. 1).

(D)   As per claim 6, Joao discloses a method as recited in claim 1, wherein the act of

notifying the carrier comprises the act of delivering a copy of the electronic image of the

supporting document to the carrier (Joao: col. 3, lines 33-45; col. 4, lines 5-11; col. 5,

lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; fig. 1).

(E)   As per claim 7, Joao discloses a method as recited in claim 1, wherein the act of

notifying the carrier comprises the act of delivering an access credential to the carrier,

the access credential being patient specific (Joao: col. 4, lines 6-10; col. 7, lines 16-24;

col. 39, lines 54-62).

(F)   As per claim 8, Joao discloses a method as recited in claim 7, wherein the

access credential is unique to the carrier (Joao: col. 4, lines 6-10; col. 7, lines 16-24;

col. 39, lines 54-62).

(G)   As per claim 9, Joao discloses a method as recited in claim 7, wherein the

access credential is specific for the combination of the carrier, the insurance claim, and

an institutional health care provider associated with the client system (Joao: col. 4, lines

6-10; col. 7, lines 16-24; col. 39, lines 54-62).

(H)   As per claim 10, Joao discloses a method as recited in claim 1, further

comprising the act of, upon receiving a request from the carrier, displaying the

electronic image of the supporting document to the carrier (Joao: col. 4, lines 5-11; col.

5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig.

1).

(I)   As per claim 11, Joao discloses a method as recited in claim 1, further

comprising the act of transmitting a request for <u>an electronic version of</u> the supporting

document to the client system, wherein <u>the electronic version of the</u> supporting

document is received by the server system in response to the request (Joao: col. 4,

lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col.

32, line 46; fig. 1).

(J)   As per claim 12, Joao discloses a method as recited in claim 11, further

comprising the act of selecting the supporting document based on information included

in the insurance claim, wherein the act of <u>transmitting a request for the electronic</u>

<u>version of</u> the supporting document is performed after and in response to the act of

selecting the supporting document (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

As per the amended recitation regarding "including one of a diagnosis code or a treatment code," Examiner respectfully submits that the technique of selecting/identifying required supporting documents based on a particular diagnosis or procedure/treatment, or based on an ICD or CPT code corresponding to a particular diagnosis or procedure/treatment for that matter, is well known and obvious.

For example, when a carrier/payer reviews/analyzes an insurance claim the carrier/payer identifies the nature of the claim based on the provided information (e.g., type of procedure performed via CPT code) and thus, determines what information must accompany that type of claim. More specifically, if a carrier/payer reviews/analyzes an insurance claim pertaining to imaging procedures performed upon a patient, the carrier/payer would select/identify the actual x-ray images (i.e., supporting documents) as being required to proceed with the claim's adjudication.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson and Applicant's prior art admissions with the teachings of Joao with the motivation of avoiding claim processing delays resulting from claim submissions with too little information (Peterson: col. 3, lines 23-30).

(K)   As per claim 13, Joao discloses a method as recited in claim 11, further comprising the act of notifying the client system that the insurance claim is eligible for advance payment, wherein the act of notifying is conducted prior to the act of

transmitting the request for the supporting document (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(L)   As per claim 14, Joao discloses in a client system that is associated with an institutional health care provider and communicates with a server system adapted to facilitate processing of an insurance claim, a method of providing a supporting document to the server system to enable a carrier associated with the insurance claim to process an insurance claim, the method comprising the acts of:

(1)   receiving, at the client system associated with the institutional health care provider, patient information, insurance information, and treatment information entered into a computer-displayable claim form displayed by the client system (Joao: abstract; col. 2, line 25-col. 4, line 5; col. 4, line 59-col. 5, line 7; col. 16, lines 38-65; fig. 1);

(2)   transmitting an insurance claim that includes the patient information, insurance information, and treatment information from the client system to the remote server computer using computer-displayable the claim form (Joao: col. 35, lines 10-35; Fig. 13A-13C);

(3)   converting the supporting document into an electronic format (Joao: abstract; col. 15, line 47-col. 16, line 18; Fig. 1-14B); and

(4)   transmitting the supporting document in <u>the</u> electronic format from the

client system (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines

11-col. 36, line 30; fig. 1).

Joao, however, fails to *expressly* disclose in a client system that is associated

with an institutional health care provider and communicates with a server system

adapted to facilitate processing of an insurance claim, a method of providing a

supporting document to the server system to enable a carrier associated with the

insurance claim to process an insurance claim, the method comprising the acts of:

(5)   identifying, by the client system, a supporting document that is required to

process the insurance claim <u>while displaying the claim form</u>.

Nevertheless, this feature is old and well known in the art, as evidenced by

Peterson. In particular, Peterson discloses disclose in a client system that is associated

with an institutional health care provider and communicates with a server system

adapted to facilitate processing of an insurance claim, a method of providing a

supporting document to the server system to enable a carrier associated with the

insurance claim to process an insurance claim, the method comprising the acts of:

(5)   identifying, by the client system, a supporting document that is required to

process the insurance claim <u>while displaying the claim form</u> (Peterson: col.

3, lines 19-30; col. 4, lines 5-20 and lines 55-61) (Examiner notes that

Peterson teaches that a user may access a claim form on-line (i.e., a

displayable electronic claim form) in conjunction with a "pre-check

process" so that the user may gain a more complete understanding of the

status of the claim (i.e., whether any additional information, such as

supporting documentation, is needed to further adjudication).

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Peterson and Applicant's prior art admisions (as discussed in

claim 1 above) with the teachings of Joao with the motivation of avoiding claim

processing delays resulting from claim submissions with too little information (Peterson:

col. 3, lines 23-30).

(M)   As per claim 15, Joao discloses a method as recited in claim 14, wherein the act

of identifying comprises receiving a request for the supporting document from the server

system (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-

62; col. 31, line 65-col. 32, line 46; fig. 1).

(N)   As per claim 16, Joao discloses a method as recited in claim 14, further

comprising the act of displaying a prompt to a medical technician using the client

system, the prompt specifying the support document to be delivered to server system

(Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(O)   As per claim 17, Joao discloses a method as recited in claim 14, further

comprising the act of receiving data from a scanner associated with the client system,

wherein the data from the scanner represents the supporting document in the electronic

format and is received in response to a paper copy of the document being scanned by

the scanner (Joao: col. 16, lines 3-18; col. 25, lines 15-19; col. 29, lines 28-40; col. 35,

lines 11-col. 36, line 30; fig. 1).

(P)   As per claim 19, Joao discloses a method as recited in claim 14, wherein the act

of transmitting the supporting document is conducted such that the carrier can process

the insurance claim without any supporting documents being sent by mail (Joao:

abstract; col. 3, line 33-col.4, line 25; col. 6, lines 45-52; fig. 1).

(Q)   As per claim 20, Joao discloses a method as recited in claim 19, wherein the act

of transmitting the supporting document is conducted such that the server system is

capable of making an electronic image of the supporting document available to the

carrier (Joao: abstract; col. 3, line 33-col.4, line 25; col. 6, lines 45-52; fig. 1).

(R)   Claims 21-22 substantially repeat the same limitations of claims 1-20 and are

therefore, rejected for the same reasons given for those claims.

(R)   As per claim 21, Joao discloses in a computer system associated with a carrier

that processes insurance claims, wherein the computer system is capable of

communicating with a server system, a method of processing an insurance claim

comprising the acts of:

(1)   receiving an insurance claim in an electronic format, <u>the insurance claim</u>

       <u>associated with a health care provider</u> (Joao: col. 3, lines 35-45; col. 4,

       line 59-col. 5, line 7);

(2)   receiving a notice indicating the accessibility of an electronic image of a

       supporting document associated with the insurance claim (Joao: col. 5,

       lines 7-18; col. 6, lines 45-55);

(3)   <u>accessing the electronic image of the supporting document</u> (Joao: col. 5,

       line 60-col. 6, line 5);

(4)   displaying the electronic image of the supporting document to enable the

       carrier to process the insurance claim (Joao: col. 21, lines 19-24); and

(5)   <u>making payment on the insurance claim to a payment entity that advanced</u>

       <u>payment on the insurance claim to a health care provider</u> (Joao: col. 37,

       lines 48-65).

Joao, however, fails to expressly disclose in a computer system associated with

a carrier that processes insurance claims, wherein the computer system is capable of

communicating with a server system, a method of processing an insurance claim

comprising the acts of:

      (5)   <u>adjudicating the insurance claim based on information in the insurance</u>

             <u>claims and in the electronic image of the supporting document</u>.

Nevertheless, these features are old and well known in the art, as evidenced by

Peterson and Applicant's prior art admissions. In particular, Peterson in a computer

system associated with a carrier that processes insurance claims, wherein the computer

system is capable of communicating with a server system, a method of processing an

insurance claim comprising the acts of:

      (5)   <u>adjudicating the insurance claim based on information in the insurance</u>

             <u>claims and in the electronic image of the supporting document</u> (Peterson:

             col. 6, lines 15-40).

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Peterson and Applicant's prior art admissions with the

teachings of Joao with the motivation of avoiding claim processing delays resulting from

claim submissions with too little information (Peterson: col. 3, lines 23-30).

(S)   As per claim 22, Joao discloses a method as recited in claim 21, further

comprising the act of receiving a credential from the server that enables the computer

system to access the electronic image (Joao: col. 4, lines 6-10; col. 7, lines 16-24; col.

39, lines 54-62).

(T)   As per claim 23, Joao fails to _expressly_ disclose a method as recited in claim 22,

wherein the credential comprises a username and a password.

        Nevertheless, this feature is old and well known in the art, as evidenced by

Peterson. In particular, Peterson discloses a method as recited in claim 22, wherein the

credential comprises a username and a password (Peterson: col. 8, lines 39-43; col. 14,

lines 25-31).

        One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Peterson and Applicant's prior art admissions with the

teachings of Joao with the motivation of avoiding claim processing delays resulting from

claim submissions with too little information (Peterson: col. 3, lines 23-30).

(U)   Claims 24-25 substantially repeat the same limitations of claims 1-20 and are

therefore, rejected for the same reasons given for those claims.

(V)   As per claim 26, Joao discloses a method as recited in claim 25, wherein the act

of requesting the electronic image comprises communicating via the Internet with a

computer associated with the server system that stores the electronic image (Joao: col. 3, line 33-col. 4, line 27).

8.   Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, Peterson and Applicant's prior art admissions, as applied to claims 1 and 14 above, and further in view of Robinson-Crowley, Christine ("Understanding Patient Financial Services" Copyright 1998. Aspen Publishers; hereinafter Robinson).

(A)   As per claim 3, Joao discloses a method as recited in claim 1, further comprising the act of determining whether the insurance claim is eligible for payment (Joao: col. 5, line 60-col. 6, line 5).

Joao, however, fails to _expressly_ disclose a method as recited in claim 1, further comprising an _advance_ payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further comprising an advance payment (Robinson: pg. 144; Examiner considers prepayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao and Peterson with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

(B)   As per claim 18, Joao discloses a method as recited in claim 14, further

comprising the act of receiving notification from the server system that the insurance

claim is eligible for payment (Joao: col. 5, lines 7-18; col. 5, line 60-col. 6, line 5; fig. 1).

Joao, however, fails to _expressly_ disclose a method as recited in claim 14, further

comprising an _advance_ payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by

Robinson. In particular, Robinson discloses a method as recited in claim 14, further

comprising an advance payment (Robinson: pg. 144; Examiner considers prepayment

to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Robinson with the teachings of Joao with the motivation of

facilitating insurance claim processing (Joao: col. 2, lines 45-55).

9.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao,

Peterson, Applicant's prior art admissions, and Robinson as applied to claim 3 above,

and further in view of Doyle, Jr. et al. (5,070,452; hereinafter Doyle).

(A)   As per claim 4, Joao fails to _expressly_ disclose a method as recited in claim 3,

wherein the act of determining whether the insurance claim is eligible for advance

payment comprises:

> (1)   determining whether the treatment information corresponds to health care
>   services that are approved for payment; and
>
> (2)   determining whether the patient is an approved beneficiary of the carrier.

Nevertheless, these features are old and well known in the art, as evidenced by Doyle. In particular, Doyle discloses a method as recited in claim 3, wherein the act of determining whether the insurance claim is eligible for advance payment comprises:

> (1)   determining whether the treatment information corresponds to health care
>   services that are approved for payment (Doyle: abstract; col. 3, lines 5-10;
>   fig. 1); and
>
> (2)   determining whether the patient is an approved beneficiary of the carrier
>   (Doyle: abstract; col. 3, lines 5-10; fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Doyle with the combined teachings of Joao, Peterson and Robinson with the motivation of providing an improved system for the administration of medical insurance claims (Doyle: col. 1, lines 65-67).

Response to Arguments

10.   Applicant's arguments filed 5/2/06 with respect to claims 1-26 have been

considered but are moot in view of the new ground(s) of rejection.

11.   Applicant's arguments filed 5/2/06 have been fully considered but they are not

persuasive. Applicant's arguments have been addressed hereinbelow in the order in

which they appear in the response filed 5/2/06.

(A)   On page 10 of the 5/2/06 response, Applicant asserts, "One of the basic

considerations applied when applying 35 U.S.C. § 103 is that the claimed invention

must be considered as a whole." Applicant further asserts that the Office Action fails to

consider the claim as a whole.

        Examiner acknowledges that the "invention" must be considered as a whole

when applying 35 U.S.C. § 103 and respectfully submits that Examiner has in fact

examined Applicant's claimed invention and the claim as a whole in light of the

combined teachings of the prior art references.

        Applicant notes that the Office Action contends that Joao teaches:

        (1)   receiving an insurance claim form the client system; and
        (2)   notifying the carrier that an electronic image of the
                supporting document is available to enable the carrier to
                process the insurance claim.

But at the same time, the Office Action acknowledges that Joao fails to disclose:

    (3) receiving a supporting document associated with the
        insurance claim in an electronic format from the client
        system.

Applicant argues that because Joao fails to disclose (3), Joao cannot disclose at

least (2). Applicant further argues that when considering the claim as a whole, it is

inconsistent to teach that an electronic image of the supporting document is available if

Joao fails to disclose receiving the supporting document.

In response, Examiner notes that Examiner initially interpreted the Joao

reference to, in fact, teach a portion of the claimed feature, that is, "receiving a

supporting document." But having considered the claimed limitation as a whole,

Examiner did not interpret the Joao reference to <u>expressly</u> teach a supporting document

"*associated* with the insurance claim" *per se*. Upon further consideration, Examiner

respectfully submits that Examiner had interpreted the Joao reference too narrowly.

Nevertheless, these arguments are moot in view of the new grounds of rejection.

On pages 11-12 of the 5/2/06 response, Applicant notes the Office Action

contends that (2) is taught when Joao states, at column 4, lines 6-11, that "[t]he

apparatus and method of the invention can utilize electronic commerce technologies

and security methods, techniques and technologies, in any and/or all of the instances of

data and/or information processing, and/or data and/or information transmission

described herein." Applicant, however, argues that this cited Joao passage fails to

consider the claim as a whole and merely recites electronic commerce technologies

without disclosing what is being sent.

In response, Examiner respectfully submits that the Applicant has failed to

consider the prior art reference *in toto* and the complete citations provided by the

Examiner. For example, at col. 5, liness 7-18, Joao teaches that, *inter alia*, information,

data, and messages may be sent electronically. At col. 6, lines 45-61, Joao teaches

that healthcare claim information may be sent electronically. Additional teachings of

"what is being sent" can be found at col. 2, line 25-col. 3, line 45 where Joao discloses

sending/providing/processing a plethora of various insurance claim and healthcare

information including documents, data, records, and other information stored within the

databases (i.e., supporting documents, such as, X-rays, as defined in the background of

the current application, 10/044,341.).

(B)   On pages 11-13 of the 5/2/06 response, Applicant argues that neither Joao nor

Peterson teach or suggest identifying a supporting document to be submitted with the

insurance claim based on information in the insurance claim as recited in claim 1.

Applicant makes similar arguments with respect to claims 14-21.

These arguments, however, are moot in view of the new grounds of rejection and

the responses to the arguments provided by Examiner above in sections 11. (A) and

(B), *supra.*

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure. The cited but not applied art teaches a claim data and document

processing system that identifies documents to be provided together with the claim to

said payer for claim reimbursement (US 2004/0205664).

The cited but not applied prior art also includes non-patent literature articles by

PR Newswire ("eStellarNet Releases StellarVue®, the First Internet Document

Management System for the Property & Casualty Insurance Industry" Nov 28, 2000. pg.

1.); and Johnson, Tom ("A New Way To Expedite Claims Delivery" May 1992. Risk

Management. Vol. 39, Iss. 5.).

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
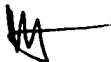
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mike Tomaszewski whose telephone number is

(571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER